

REMARKS

Claims 1-47 are pending. Claims 1-24 have been rejected under 35 U.S.C. § 112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the invention. Claim 1 and 5 have been amended to clarify, particularly point out and distinctly claim the invention. Claims 2-4 and 6-24 depend, either directly or indirectly, from claims 1 and 5. Therefore, in light of the amendments, the Applicant requests that the rejection of claim 1-24 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claims 1-4, 9, 11, 25-30, 32-33, 38-42 and 44-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,197,062 (the '062 patent) in view of U.S. Patent No. 5,910,171 (the '171 patent) for being obvious.

To establish a *prima facie* case of obviousness it is necessary to make a showing of motivation to combine the references that purportedly make the claims obvious. The Examiner has not made any such showing. The '062 patent teaches that "once a particular connector 50 has been chosen, there is only one way in which it can be positioned in relation to stem 10 and therefore also only one way in which it orients head 30 relative to the stem." ('062 patent at col. 3 ll. 1-4.) In fact, the '062 patent touts this feature as minimizing the chances of misalignment of a connector 50. The '062 patent's emphasis on having only one way in which connector 50 can be positioned in relation to stem 10, teaches against the use of neck and stem registration elements that can lock in multiple positions. Thus, it is improper to combine the '171 reference with a reference -the '062 reference - that teaches against the main thrust of the '171 reference's teachings. Since the Examiner's combining of these two references is improper, consequently the rejection of claims under 35 U.S.C. § 103(a) is improper and must be withdrawn.

Alternatively, to make a claim obvious, the references must teach, disclose or suggest all elements of a claim. As explained hereafter, the cited references taken together fail to teach, disclose or suggest all elements of claims 1-4, 9, 11, 25-30, 32-33, 38-42 and 44-47, and therefore do not render these claims obvious.

Independent claim 1, as amended, in part, recites that "a stem registration element that ... prevent[s] the first neck from taper locking in the bore of at least one stem."

Independent claim 25, as amended, in part, recites that "the stem registration element of one of the plurality of necks prevents that neck from taper locking in the bore of one of the plurality of stems."

Independent claim 38, in part, recites "a third neck having a stem registration element that cannot register with at least one neck in any position."

Independent claim 39, in part, recites "at least one neck of said plurality of necks having a registration element which engages said registration element of at least one of said stems in a manner which prevents said tapered bore and said tapered neck portion from locking engagement in any circumferential position."

Independent claim 46, in part, recites "at least one neck of said plurality of necks having a registration element which engages the registration element of at least one of said stems in a manner which prevents the engagement of said stem and neck locking portions in any circumferential position."

Independent claims 1, 25, 38, 39 and 46 are drawn to a kit of parts. The language cited above makes it clear that each claimed kit of parts includes at least one neck and at least one stem that are prevented from locking with each other.

The Examiner, on page 3 of the Office Action admits that the '062 patent does not teach, disclose or suggest neck

and stem registration elements that prevent locking of the stem and neck in any position. However, the examiner claims that the '171 patent overcomes the deficiency of the '062 patent. The Applicant respectfully disagrees.

The '171 patent teaches various geometric structures for the shaft and the bore seats. However, it makes it abundantly clear that these shapes are alternative to each other. (U.S. Patent No. 5,910,171, col. 8, ll. 46-47 (FIGS. 13, 14 and 15 represent alternate geometric structures for the shaft and the bore seats.)) In other words, the '171 patent teaches that a shaft may be made of various shapes as illustrated in figures 13, 14 and 15 of the '171 patent. However, the shaft having a shape shown in figure 13 would be used with a bore having a corresponding shape shown in figure 13. Never does the '171 patent teach, disclose or suggest that a shaft having shape shown in figure 13 may be used with a bore having a shape shown in figure 14 or 15 to ensure that the shaft and the bore would not mate thereby preventing the undesirable mating of certain necks with certain stems. The '171 patent does not address the problem of preventing mating of certain stems with certain shafts (or necks) to avoid creating prosthetic devices of undesirable shape. The teaching of the '171 patent is limited to various shapes for mating shaft and bores.

Since the '171 patent does not overcome the deficiency of the '062 patent, the cited references individually or combined fail to teach, disclose or suggest all limitations of claims 1, 25, 38, 39 and 46. Particularly the cited references fail to teach, disclose or suggest the limitations of claims 1, 25, 38, 39 and 46 that were quoted above. Therefore, claims 1, 25, 38, 39 and 46 are not obvious over the cited references. Claims 2-4, 9 and 11 depend either directly or indirectly from claim 1 and are not obvious over the cited references for at least the same reasons as claim 1. Claims 26-30, 32-33 depend

either directly or indirectly from claim 25 and are not obvious over the cited references for at least the same reasons as claim 25. Claims 40-42, 44 and 45 depend either directly or indirectly from claim 39 and are not obvious over the cited references for at least the same reasons as claim 39. Claim 47 depends from claim 46 and is not obvious over the cited references for at least the same reasons as claim 46.

The Applicants thank the Examiner for indicating that claims 5-8, 10, 12-24, 31, 34-37 and 43 would be allowable if rewritten in independent form including all off the limitations of the base claim and any intervening claims. However, in view of the above amendments and remarks, Applicants believe that no amendment to these claims is necessary and that these claims are allowable in their present form.

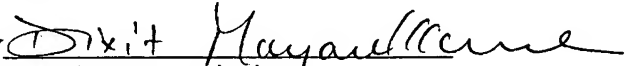
As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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